

REMARKS

Reconsideration of the application is requested in view of the above amendments and the following remarks. Claims 1-17, 19, 20-23 and 25-43 have been amended. New claims 44-51 have been added. The amended and new claims are supported by at least the figures and detailed description of those figures in the present application. Claim 51 includes the allowable subject matter of claim 14 re-written in independent form. No new matter has been added.

Objections and § 112 Rejections

The first paragraph of the specification and claim 43 have been amended to address the objections noted by the Examiner at page 3 of the Office Action.

Claim 25 was rejected under 35 U.S.C. § 112, 2nd paragraph, as being indefinite. Claim 25 has been amended to address this rejection and is now definite.

§ 102 Rejections

Claim 38 was rejected under 35 U.S.C. § 102(b) as being anticipated by Hawkinson (US 5,542,407). Applicants respectfully traverse this rejection.

Hawkinson discloses with reference to Figure 3 a fireplace 110 that includes a combustion chamber 112 defined by an upper wall 114, a lower wall 116, a pair of sidewalls 118 (only one of which can be seen) and a pair of glass panes 120. A second set of glass panes 122 are spaced apart from the panes 120 to define air passageways 124. The air passageways 124 are in fluid communication with an air inlet vent 126. This configuration provides for inlet air to be drawn through the vent 126 and the passageways 124 to the bottom of the combustion chamber 112 where it supplies combustion air to the burner assembly 126.

Hawkinson fails to disclose a combustion air enclosure or positioning the combustion chamber enclosure inside a combustion air enclosure. Hawkinson further fails to disclose

securing a glass panel to the combustion chamber enclosure with the combustion air enclosure positioned there between, as required by claim 38. As shown in Figure 3 of Hawkinson, the glass panels 120, 122 are not secured to the combustion chamber enclosure (defined by panels 114, 116, 118) with a combustion air enclosure positioned between the glass panel and the combustion chamber enclosure 112. The rejection fails to properly identify a combustion air enclosure or the features of the combustion chamber 112 that meet the limitations of claim 38. Therefore, Hawkinson fails to disclose every limitation of claim 38.

§ 103 Rejections

Claims 1, 2, 5-7 and 17-22 were rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative under 35 U.S.C. § 103(a) as being obvious over Cakebread (US 6,138,667). Applicants respectfully traverse this rejection.

Cakebread discloses a typical direct vent fireplace construction that includes an outer casing 12, a firebox 22 and a coaxial exhaust and air intake system 48, 42. Room air is drawn into the plenum space defined between the outer casing 12 and firebox 22 through a grill assembly 38. Heated air from that plenum space is exhausted back into the room via the grill assembly 36. An air intake duct 44 extends along a rear wall 24 of the firebox and is in fluid communication with the air intake duct 42 thereby providing combustion air into the firebox 22 via a plurality of outlets 46. A glass door assembly 40 closes off the front of the firebox 22 and is coplanar with a front panel of the fireplace.

Cakebread fails to disclose "wherein the front panel of the combustion chamber is spaced rearward of and arranged substantially parallel with the front panel of the outer enclosure," as required by claim 1. As noted in Figure 3 of Cakebread, the glass doors 40, which serve as the front panel of the firebox 22 are coplanar with the front surface/panel of the outer casing 12. Therefore, Cakebread fails to disclose every limitation of claim 1.

Cakebread also fails to disclose "an access panel extending in a direction substantially perpendicular to the front panel of the combustion chamber enclosure between the front panel of the combustion chamber enclosure and the front panel of the outer enclosure," as required by

claim 1. As noted above, Cakebread fails to disclose or suggest the front panel of the combustion chamber enclosure is spaced rearward of the front panel of the outer enclosure. Therefore, it is not possible for an access panel, if such a panel were disclosed by Cakebread, to extend in a direction substantially perpendicular to the doors 40 between the front panels. The rejection points to the lower grill 38 as being an inherently removable member for accessing controls beneath the bottom panel 34 of the firebox 22. However, the grill 38 is not between the glass doors 40 and a front panel of the outer casing 12. Further, the grill 38 does not extend in a direction substantially perpendicular to the doors 40. Therefore, Cakebread fails to disclose every limitation of claim 1 for this additional reason.

Concerning claim 17, Cakebread discloses a plurality of controls 60, 62, 64, 66, 67, 68 positioned on a bottom side of a mounting plate 34 and bottom plate 32 of the firebox 22. Cakebread fails to disclose or suggest that these controls could be positioned "between the outer enclosure and one of the side panels of the combustion chamber enclosure," as required by claim 17.

Positioning of the controls of the heating appliance between the outer enclosure and a side panel of the combustion chamber enclosure provides certain advantages as described, for example, at page 6, lines 6-18 of the present specification. One such advantage is that the space between the bottom panel of the combustion chamber enclosure and the bottom panel of the outer enclosure can be substantially eliminated so as to create a flush mounting between the bottom panel of the combustion chamber enclosure and a top surface of the hearth formed directly in front of the heating appliance. Another advantage is that in many instances it is less cumbersome to access controls that are positioned along a side of the combustion chamber enclosure versus having to access those controls from underneath the combustion chamber enclosure. Cakebread fails to disclose or suggest every limitation of claim 17 and the claims that depend from it, nor the advantages associated with the configuration of those claims.

Claims 3, 4, 28-34 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cakebread in view of Hawkinson. Applicants respectfully traverse this rejection.

As noted above, Cakebread fails to disclose or suggest every limitation of claims 1 and 17. Hawkinson fails to remedy the deficiencies of Cakebread as it relates to claims 1 and 17.

Therefore, claims 3, 4 and 28 are allowable for at least the reason they are dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection as it relates to claims 3, 4 and 28.

Further to the above, neither Cakebread nor Hawkinson discloses a combustion air enclosure that extends around substantially all of the side panel of the combustion chamber enclosure. As discussed above, Cakebread discloses a panel 44 that extends along a rear panel 24 of the firebox 22. Hawkinson discloses air chambers 124 that extend along the viewable front/rear surfaces of the fireplace 110. However, neither of these references disclose an air enclosure along a side panel of the combustion chamber enclosure. Therefore, claim 4 is allowable for this additional reason.

Concerning claim 29, Cakebread discloses a panel 44 that extends along a rear panel 24 of the firebox 22. The position of panel 24 is common for many direct vent fireplaces because it provides an air path that extends directly from the intake vent 42 to apertures 46 formed in the rear panel. There is no suggestion by Cakebread of providing a different air flow path from the air intake vent 42 to the apertures 46, or of providing the apertures 46 at any location besides at the rear panel 24.

Hawkinson discloses an air wash system in Figure 3 that provides cooling of the outer exposed viewing panels 122 by passing fresh air in the plenum space 124 between the two viewable panels 120, 122 on opposing sides of the fireplace 110. Such an air wash system for the purpose of cooling exposed outer panels is not necessary nor is it disclosed or suggested by Hawkinson for the side panels 118 of the combustion chamber or side panels of the outer enclosure of the fireplace 110.

Claim 29 requires a combustion air enclosure configuration that provides advantages neither disclosed nor suggested by the cited references. The combustion air enclosure of claim 29 at least partially extends around an outer surface of the rear and first and second side panels of the combustion chamber enclosure. A resultant advantage of this configuration is that "a hole formed through any of the rear and first and second side panels of the combustion chamber enclosure provide an inlet for combustion air to enter the combustion chamber from the combustion air chamber." Thus, combustion air inlets can be provided at any desired location on

the rear and side panels that correspond to the position of the combustion air enclosure extending around those panels. As noted above, Cakebread discloses forming apertures 46 on a single, rear panel of the firebox 22. Hawkinson does not disclose combustion air apertures formed in the side panels 118, or either of the glass panels 120, 124. Without some disclosure or suggestion of positioning the combustion air enclosure at least partially extending around an outer surface of all of the rear and first and second side panels of the combustion chamber enclosure, or of forming a hole through any of the rear and first and second side panels to provide a combustion air inlet, the rejection has failed to set forth a *prima facie* case of obviousness to the limitations of claim 29 and the claims that depend from it. Withdrawal of the rejection is respectfully requested.

Claims 35 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cakebread in view of Hawkinson and further in view of Lyons (US 6,170,481). Applicants respectfully traverse this rejection.

As discussed above, Cakebread and Hawkinson fail to disclose or suggest every limitation of claim 29. Lyons fails to remedy the deficiencies of Cakebread and Hawkinson as they relate to claim 29. Therefore claims 35 and 36 are allowable for at least the reason they are dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

Claims 9, 11, and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cakebread. Applicants respectfully traverse this rejection.

As noted above, Cakebread fails to disclose or suggest every limitation of claims 1 and 17. Therefore, claims 9, 11 and 26 are allowable for at least the reason they are dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

Concerning claim 11, Applicants refer to the advantages of placing fireplace controls on a side of the combustion chamber described at page 6, lines 6-18 of the present specification. Applicants submit that providing controls on the side of the combustion chamber enclosure can improve the accessibility of the controls because of the increased height of the controls relative to a user and the possibility of increased visibility of those controls. Another advantage may be

the option of flush mounting a bottom panel of the combustion chamber enclosure with a hearth structure formed in front of the heating appliance and the related reduced clearance necessary between the bottom panel of the combustion chamber enclosure and the bottom panel of the outer enclosure. Therefore, the limitations of claim 11 provide certain advantages and solve problems that are more than a design choice. Applicants submit that the art of record and one skilled in the art does not render obvious the limitations of claim 11.

Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Cakebread in view of Hawkinson. Applicants respectfully traverse this rejection. As discussed above, Cakebread fails to disclose or suggest every limitation of claim 1. Hawkinson fails to remedy the deficiencies of Cakebread as it relates to claim 1. Therefore claim 10 is allowable for at least the reason it is dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Cakebread in view of Wittaker (US 4,726,351). Applicants respectfully traverse this rejection. As discussed above, Cakebread fails to disclose or suggest every limitation of claim 1. Wittaker fails to remedy the deficiencies of Cakebread as it relates to claim 1. Therefore, claim 12 is allowable for at least the reason it is dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

Claims 13, 23, and 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cakebread in view of Buffington (US 2,003/0019490). Applicants respectfully traverse this rejection. As discussed above, Cakebread fails to disclose or suggest every limitation of claims 1 and 17. Buffington fails to remedy the deficiencies of Cakebread as it relates to claims 1 and 17. Therefore, claims 13, 23 and 27 are allowable for at least the reason they are dependent upon an allowable base claim.

Further, claims 13 and 23 require that each of the side and rear portions/panels include a planar portion, and that the intersection of the side and rear panels, portions are contoured. Cakebread fails to disclose or suggest contoured surfaces in the firebox 22. Buffington discloses an arced surface that is a continuously contoured surface that does not include planar portions on the side and rear panels/portions of the combustion chamber enclosure. Therefore, Cakebread

and Buffington fail to disclose or suggest every limitation of claims 13 and 23 for this additional reason.

Claim 27 requires that the contoured surface include an overlapping brick arrangement that provides a shelf feature. Neither Cakebread nor Buffington discloses or suggests an overlapping brick arrangement within the contoured surface that provides a shelf feature. Therefore, claim 27 is also allowable for this additional reason.

Claims 15, 24 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cakebread in view of Lyons. As discussed above, Cakebread fails to disclose or suggest every limitation of claims 1 and 17. Lyons fails to remedy the deficiencies of Cakebread as it relates to claims 1 and 17. Therefore, claims 15, 24 and 25 are allowable for at the least the reason they are dependent upon an allowable base claim. Applicants do not concede the correctness of this rejection.

Claims 8, 16 and 39-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Cakebread in view of Peterson (US 4,913,131). Applicants respectfully traverse this rejection.

Concerning claim 8, neither Cakebread nor Peterson discloses or suggests first and second side members of the access panel that are aligned substantially coplanar with side surfaces of the combustion chamber enclosure, or a bottom member of the access panel that is aligned substantially coplanar with a bottom surface of the combustion chamber enclosure. The grates 36, 38 disclosed by Cakebread and the surround members 43, 44, 45, 51, 46 and grates 47, 48 of Peterson are all aligned substantially co-planar with a front surface or front panel of the fireplace. Therefore, Cakebread and Peterson fail to disclose or suggest every limitation of claim 8.

Concerning claim 16, neither Cakebread nor Peterson discloses or suggests a side panel of the combustion chamber enclosure that includes an air passage aperture to promote air flow between the combustion chamber and the combustion air chamber. Therefore, claim 16 is allowable over the cited references.

Concerning claim 39, Peterson discloses a plurality of surround members 43, 44, 45, 46, 51 and louvers 47, 48 that cover portions of a fireplace front 30 having louvers 40, 42 formed therein. The fireplace also includes door sections 35, 36 having frame portions across the top and bottom ends of the doors. None of the surround pieces 43, 44, 45, 46, 51 or louvers 47, 48 are a "surround member adapted and configured to be positioned between the front panel of the outer enclosure and the glass panel to cover the glass frame from view." There is no teaching or suggestion by Peterson or Cakebread of a surround member that covers a frame of the glass panel that is secured to a front surface of the combustion chamber enclosure. Furthermore, the surround pieces 43, 44, 45, 46, 51 and louvers 47, 48 are not "positioned between the front panel of the outer enclosure and the glass panel." Therefore, Cakebread and Peterson fail to disclose or suggest every limitation of claim 39 and the claims that depend from it.

New Claims

New claim 44 is directed to a direct vent fireplace that includes a combustion air enclosure positioned between the outer and enclosure and a side and a rear panel of the combustion chamber enclosure through which no viewing of the combustion chamber is provided. The combustion air enclosure of claim 44 together with a combustion chamber enclosure defines an air insulative space between the combustion chamber and the outer enclosure of the fireplace. None of the art of record discloses or suggests a combustion air enclosure positioned between both a side and a rear panel of the combustion chamber enclosure to define an air insulative space. The cited art of record also fails to disclose or suggest every limitation of dependent claims 44-50 that depend from new claim 44.

New claim 51 includes the limitations of allowable claim 14 rewritten in independent form. Applicants request consideration and allowance of new claims 44-51.

JUN-21-05

15:54

FROM-Merchant & Gould

6123329081

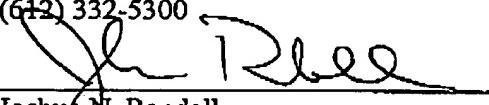
T-985 P.023/025 F-583

In view of the above, Applicants request reconsideration of the application in the form of a Notice of Allowance. If a phone conference would be helpful in resolving any issues related to this matter, please contact Applicants' attorney listed below at 612-371-5387.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: Feb. 28, 2005


Joshua N. Randall
Reg. No. 50,719

MEMORY TRANSMISSION REPORT

PAGE : 001
 TIME : 02-28-05 08:37
 TEL NUMBER1: 6123329081
 TEL NUMBER2: 6123329081
 NAME : Merchant & Gould

FILE NUMBER : 163
 DATE : 02-28 08:31
 TO : 617038729306
 DOCUMENT PAGES : 022
 START TIME : 02-28 08:31
 END TIME : 02-28 08:37
 SENT PAGES : 022
 STATUS : OK

FILE NUMBER : 163 *** SUCCESSFUL TX NOTICE ***

Merchant & Gould
 An Intellectual Property Law Firm

3300 IDS Center
 80 South Eighth Street
 Minneapolis, Minnesota
 55402-2215 USA
 tel. 612.332.5300
 fax 612.332.9081
 www.merchant-
 gould.com

A Professional Corporation

Fax Transmission | February 28, 2005

TO: Commissioner for Patents
 Attn: Examiner J. Cocke
 P.O. Box 1450
 Alexandria, VA 22313-1450

FROM: Joshua N. Randall

OUR REF: 12929.1123US01
 TELEPHONE: 612.371.5387

Total pages, including cover letter: 22

PTO FAX NUMBER 1-703-872-9306

If you do NOT receive all of the pages, please telephone us at 612.336.4664, or fax us at 612.332.9081.

Title of Document Transmitted: AMENDMENT

Applicant: LYONS ET AL.
 Serial No.: 19718.053
 Filed: NOVEMBER 19, 2003
 Group Art. Unit: 3749
 Our Ref. No.: 12929.1123US01
 Confirmation No. 2204

Please charge Deposit Account No. 13-2725 in the amount of \$800 for extra claims fees; \$400 for extra claims and \$400 for 2 extra independent claims. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to cover these papers, if appropriate.

By:
 Name: Joshua N. Randall
 Reg. No.: 20,712

I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below.

Address Faxed
 Signature

2/28/05
 Date

GENRAN.DOT

Auto-Reply Facsimile Transmission



TO: Fax Sender at 6123329081

Fax Information

Date Received:

Total Pages:

2/28/2005 9:33:40 AM [Eastern Standard Time]

22 (including cover page)

ADVISORY: This is an automatically generated return receipt confirmation of the facsimile transmission received by the Office. Please check to make sure that the number of pages listed as received in Total Pages above matches what was intended to be sent. Applicants are advised to retain this receipt in the unlikely event that proof of this facsimile transmission is necessary. Applicants are also advised to use the certificate of facsimile transmission procedures set forth in 37 CFR 1.8(a) and (b), 37 CFR 1.6(f). Trademark Applicants, also see the Trademark Manual of Examining Procedure (TMEP) section 306 et seq.

Received
Cover
Page
=====>

02-20-05	11:22	FROM-Merchant & Gould	6123329081	T-885	P.001	F-1C9
Merchant & Gould <small>An Intellectual Property Law Firm</small>				<small>3700 12th Street NW Suite 1400 Washington, DC 20004 301-231-1500 tel. 612-332-5000 fax 612-332-9081 www.mgclaw.com gold@mgclaw.com</small>		
<p>Fax Transmission February 28, 2005</p> <p>TO: Commissioner for Patents Attn: Examiner J. Cocks P.O. Box 1450 Alexandria, VA 22313-1450 FROM: Joshua N. Randall</p> <p>OUR REF: 12929.1123US01 TELEPHONE: 612-371-5387</p> <p>Total pages, including cover letter: 22</p> <p>FAX NUMBER 1.703.572.9306</p> <p>If you do NOT receive all of the pages, please telephone us at 612.336.4664, or fax us at 612.332.9081.</p> <p>Title of Document Transmitted: <u>AMENDMENT</u></p> <p>Applicant: LYONS ET AL. Serial No.: 10718,053 Filed: NOVEMBER 19, 2003 Group Act Unit: 3749 Our Ref. No.: 12929.1123US01 Confirmation No. 9504</p> <p>Please charge Deposit Account No. 13-2725 in the amount of \$800 for extra claims fees; \$400 for extra claims and \$400 for 2 extra independent claims. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate.</p> <p>By: <u>Joshua N. Randall</u> Name: Joshua N. Randall Reg. No.: 30,719</p> <p>I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below:</p> <p><u>Andrea Endres</u> <u>2/28/05</u> Signature Date</p> <p style="text-align: center;"><small>02/28/2005</small></p> <p>PAGE 122 * RCV'D AT 2/28/2005 9:33:40 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-1/7 * DNIS:8729306 * CSID:6123329081 * DURATION (mm:ss):06:52</p>						